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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,216	07/20/2000	PETER FICKEISEN	193413USOPCT	2523

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/06/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/582,216

Applicant(s)

FICKEISEN ET AL.

Examiner

Callie E. Shosho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 February 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112 rejection.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 9-35.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

**Attachment to Advisory Action**

1. Applicants' arguments filed 2/15/02 have been fully considered but they are not persuasive.

(a) Specifically, applicants argue that CA 2,182,743 fails to disclose or suggest an aqueous polymer dispersion having a combination of gel content, number-average molecular weight, and amount/type of filler as presently claimed. Applicants further argue that none of the examples of CA 2,182,743 disclose polymers having both claimed gel content and number-average molecular weight as presently claimed. As evidence to support this position, applicants have filed a 1.132 declaration wherein the gel content and number-average molecular weight of the tetrahydrofuran-soluble fraction were determined for each of the polymers in examples 1-4 of CA 2,182,743. The declaration shows that none of the polymers possess both gel content and number-average molecular weight of the tetrahydrofuran-soluble fraction as presently claimed.

However, applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960).

Although CA 2,182,743 do not disclose any examples which meet both the claimed gel content and number-average molecular weight, it is significant to note that CA 2,182,743 disclose polymer obtained from monomers identical to that presently claimed which has gel content of 0-90%, preferably 20-70%, and most preferably 40-60%. Although there is no explicit disclosure of the number average molecular weight of the soluble fraction of the polymer, given

that the polymer is identical to that presently claimed and possesses the same gel content as presently claimed and further given that the same type of polymerization process is "particularly preferred" in both the instant application (see page 4, lines 38-40) and CA 2,182,743 (see page 3, lines 39-41), it is clear that the number average molecular weight of the soluble fraction would inherently be the same as presently claimed. Examiner's position regarding the number-average molecular weight is supported by applicants' declaration, which discloses that CA 2,182,743 does in fact utilize polymers with number average molecular weight of the tetrahydrofuran-soluble fraction less than 30,000 (example 4 of CA 2,182,743). Applicants also argue that CA 2,182,743 does not disclose the use of filler as presently claimed. However, it is noted that examples 1A-4A on page 11 of the reference do disclose the use of chalk filler presently claimed. Although there is no disclosure in the examples of quartz flour filler or combination of chalk and quartz flour filler as presently claimed, it is noted that page 4, lines 41-46 of CA 2,182,743 does disclose that the fillers utilized include chalk and/or quartz flour filler as presently claimed.

With regards to the comparative data set forth in Table 3 of the present specification, applicants argue that the data establishes the criticality of the combination of the presently claimed gel content and number-average molecular weight. It is noted that the data compares aqueous composition comprising polymer within the scope of the present claimed, i.e. having gel content and number-average molecular weight as presently claimed (example 4) with aqueous composition comprising polymer outside the scope of the present claimed, i.e. having claimed number-average molecular weight, but with gel content outside the scope of the present claims (comparative examples 1-3). Applicants state that the claimed aqueous composition exhibits

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superior wet bonding capacity and that such wet bonding capacity is only exhibited when using polymers with combination of gel content and number-average molecular weight as presently claimed. However, examples 1A and 3A of CA 2,182,743 which according to applicants' declaration have gel content and/or number-average molecular weight outside the scope of the present claims also exhibit superior wet bonding capacity either similar to or superior to the values exhibited by the aqueous compositions of the present invention. Thus, it is examiner's position that the comparative data does not establish unexpected or surprising results over CA 2,182,743 given that the reference already discloses polymers with gel content and number-average molecular weight as presently claimed and further, given that the compositions of CA 2,182,743 also exhibit the same superior wet bonding capacity as the present invention.


(b) Applicants also argue that there is no disclosure in Kawashima et al. or Tsuruoka et al. of filler as presently claimed.

It is agreed that Kawashima et al. do not disclose filler as presently claimed which is why this reference is used in combination with CA 2,182,743, which as described above, discloses the use of chalk and/or quartz flour identical to that presently claimed in order to produce a composition with good wet and dry grab and good heat distortion resistance.

With respect to Tsuruoka et al., it is noted that col. 11, lines 36-39 of Tsuruoka et al. disclose the use of calcium carbonate, i.e. chalk, having average particle diameter less than 5  $\mu\text{m}$ .

  
Callie Shosho

3/2/02

  
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